

REMARKS

Reconsideration of this application is respectfully requested. The undersigned, on behalf of applicants, thanks the examiner for the helpful courtesies and remarks extended during the examiner interview. This amendment and the following remarks are believed consistent with the discussions during the interview.

Claims 1-9 and 36-61 are presently pending in this application. Claims 10-35 previously canceled without prejudice due to an inadvertence in claim numbering have been earlier presented as new claims 36-61. By this amendment, claims 43-46 again are presented for examination.

Claims 1-9, 36-42 and 47-61 stand withdrawn pursuant to restriction requirement, the restriction requirement having been made final.

Claim 43 has been amended to recite that THP is tetrahydropyranl. THP, as described at page 25 of the specification, is tetrahydropyranl. The amendment to claim 43 therefore does not present new matter. In addition, the amendment to claim 43 also does not constitute a narrowing amendment for purposes of patentability. Indeed, the amendment to claim 43 is merely cosmetic since one of ordinary skill would immediately recognize that THP is tetrahydropyranl is explicitly defined in, such as, page 25 of the specification.

In the office action, claims 43-46 have been rejected under 35 U.S.C. § 35 U.S.C. § 103(a) as obvious over the Hofmann et al. reference entitled " Synthesis of Polyphosphazenes with Sulfonimide Side Groups" cited by examiner in Chem Abstract 137:217352.

In response, applicant notes that the literature reference to Hofmann et al. published on the web on July 17, 2002. The publication date of Hofmann et al. therefore is within one year of the February 13, 2002 priority date of above-identified application. The literature reference to Hofmann et al. therefore is not a statutory bar.

As discussed in MPEP 715.01(c), unless it is a statutory bar, a rejection based on a literature reference may be overcome by a showing that the reference was published either by applicant himself/herself or on his/her behalf. The attached

Declaration establishes that the cited reference is applicant's own work. In this connection, the Declarations show that applicants are the sole inventors and that the other authors of the Hofmann et al. literature reference merely worked under the direction of the applicants. Such Declarations have been found sufficient to remove the Hofmann et al. reference. See *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1902). Accordingly, it is respectfully submitted that Hofmann et al. is ineffective as a reference against any of claims 43-46, and should be withdrawn. Claims 43-46 therefore are patentable over Hofmann et al.

In order to expedite prosecution, applicants submitted a Declaration under 37 CFR 1.132. That Declaration established that the Hofmann et al. reference is the publication of the invention of each of the six named applicants of the above-identified application and that Hofmann et al. reference is not the publication of "another."

The examiner found that that Declaration insufficient because applicants Welna and Wood did not sign that Declaration. Applicants therefore attach a declaration signed by Welna and Wood.

The attached declaration by Welna and Wood, as well as the previously submitted declarations, show that claimed phenoxy sulfonimide functionalized polyphosphazene copolymer $[NP(ZR^2)_x(ZC_6H_4SO_2NR^1SO_2R_f)_{2-x}]_n$ where R_f is a C_1 - C_8 perfluoroalkyl, where R^2 is selected from the group consisting of $-CH_2CH_3$, $-C_6H_4CH_3$, $-CH_2CH_2OCH_2CH_2OCH_3$, $-CH_2CH_2OTHP$, $-C_6H_4COOPr$, $-CH_2CF_3$, $CH_2CF_2OCF_2CF_2OCF_3$, $-C_6H_4CF_3$, $-C_6F_5$, and mixtures thereof, Z is O or NH, and R^1 is Na, as well as its synthesis, is the work of all of the applicants and is directly attributable to all of the applicants. Therefore, in accordance with MPEP 716.10, applicants respectfully submit that the Hofmann et al. reference should be withdrawn since the sodium species and the method of making the phosphazene monomer and copolymer disclosed therein is directly attributable to the applicants.

This declaration, together with the previously submitted declaration, establishes that the Hofmann et al. reference is ineffective as a reference against any of

claims 43-46, and should be withdrawn. Claims 43-46 therefore are patentable over Hofmann et al. The present declaration was not previously submitted because the previous declaration clearly referenced the contribution of the declarants of the present declaration.

In addition, none of claims 43 to 46 is taught or suggested by Hoffman et al. Nothing in Hoffman et al. teaches or suggests any of the additional species such as Li, H, and K. One of ordinary skill in the art therefore would not be motivated by Hofmann et al. to achieve any of claims 43-46 where R¹ is any of Li, H and K.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 43-46 have been rejected under 35 USC 112, second paragraph as indefinite. The examiner asserts that numerical ranges should be recited in connection with each of subscripts "x" and "n" in the claimed formula $[NP(ZR^2)_x(ZC_6H_4SO_2NR^1SO_2R_f)_{2-x}]_n$.

As is well known in the art of phosphazene chemistry, there are two possible substituent (side-groups) per P atom and those substituents may differ. See "Phosphorus-Nitrogen Compounds", Allcock, pub: Academic Press Inc., New York, 1972, pp 3-4, a copy of which is attached for the examiners convenience. Since there are two substituent groups per P atom, then it would be clear to one of ordinary skill that x may be 0, 1, or 2 in the claimed formula $[NP(ZR^2)_x(ZC_6H_4SO_2NR^1SO_2R_f)_{2-x}]_n$. In this connection, where x is 0, then two "(ZC₆H₄SO₂NR¹SO₂R_f)" substituents are attached to the P atom; where x is 2, two "(ZR²)" units are attached to the P atom; where x is 1, one "(ZR²)" substituent and one "(ZC₆H₄SO₂NR¹SO₂R_f)" substituent is attached to the P atom. A polymer results when, as would be clear to one of ordinary skill in the art, more than one unit of the claimed formula $[NP(ZR^2)_x(ZC_6H_4SO_2NR^1SO_2R_f)_{2-x}]_n$ is present in the polymer chain, i.e, n>1. In such a polymer, x also may be a non-integer between 0 and 2 that represents the average value for the entire polymer chain. Such values of x would be clear to those of ordinary skill. Again, see "Phosphorus-Nitrogen Compounds", Allcock, pub: Academic Press Inc., New York, 1972, pp 3-4.

In view of the above, applicants respectfully submit that one of ordinary skill would understand and recognize the range of possible values of the subscript x.

In connection with the subscript n, and as would be recognized by one of ordinary skill in the art, subscript n need not have a specific numerical value. This is because one of ordinary skill in the art recognizes that the number of units in a polymer chain may be any number greater than one.

In view of the forgoing, applicants respectfully submit that one of ordinary skill, given the claimed formula $[NP(ZR^2)_x(ZC_6H_4SO_2NR^1SO_2R_t)_{2-x}]_n$, would readily be able to determine the range of values of the x subscript so as to assess the metes and bounds of the claim. Applicants also respectfully submit that one of ordinary skill would clearly know that when n has an interger value greater than one that a polymer chain results and therefore would readily be able assess the metes and bounds of the claim.


Applicants submit that 35 USC 112, 2nd paragraph is satisfied if a person skilled in the field of the invention would reasonably understand the claim when read in the context of the specification. See Union Pac. Res. Co. v. Chesapeake Energy Corp., 236 F.3d 684, 692 (Fed. Cir. 2001) (the definiteness requirement set forth in § 112, 2nd paragraph, "focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification"); Miles Lab., Inc. v. Shandon, 997 F.2d 870, 875 (Fed. Cir. 1993) (if the claims "reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more"); In re Moore, 58 C.C.P.A. 1042, 439 F.2d 1232, 1235 (CCPA 1971) (the indefiniteness inquiry asks whether the claims "circumscribe a particular area with a reasonable degree of precision and particularity").

Applicants respectfully submit that claims 43-46 satisfy the requirements of 35 USC 112, 2nd paragraph. Here, it is clear that a person skilled in the field of claims 43-46 would reasonably understand the scope of those claims when read in the context of the specification. It also is clear that claims 43-46 reasonably apprise those skilled in the art of the scope of the claims with a reasonable degree of precision and

particularity. One of ordinary skill, when assessing the metes and bounds of the claims in light of the specification, therefore would readily be able to assess the range of the values of x and would know that $n > 1$.

In view of the forgoing, applicants respectfully submit that the claims are in condition of allowance. Such action is respectfully solicited.

Respectfully Submitted,



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